



[AP32438 – 070121.0425]  
PATENT

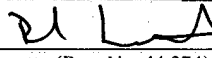
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s) : Thomas A. SHREINER et al.  
Appln. Serial No. : 09/593,785  
Filed : June 14, 2000  
Entitled : EXPANSION JOINT COVER WITH MODULAR  
CENTER PLATE  
Group Art Unit : 3635  
Examiner : Chi Q. Nguyen

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

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December 16, 2004

  
David Loretto (Reg. No. 44,374)

**RESPONSE TO NOVEMBER 16, 2004 AND NOVEMBER 30, 2004,**

**OFFICE COMMUNICATIONS**

Sir:

The enclosed Amended Appeal Brief and Amendment After Final were prepared in response to the Office communication mailed on November 16, 2004, which rejected the Amendment After Final submitted by Applicants on July 29, 2004, and a telephone communication with Examiner Nguyen on November 30, 2004, directed to the Amendedment After Final and the Appeal Brief submitted on July 29, 2004.

After these papers were prepared for filing, Applicants received the Office communication dated November 30, 2004, directed to the Appeal Brief. As set forth below, Applicants submit that the revised Amendment After Final and Amended Appeal Brief are responsive to the Office communication mailed on November 30, 2004.

#### **AMENDMENT AFTER FINAL**

In the November 16, 2004, Office communication, the Examiner declined to enter the proposed Amendment After Final on the grounds that it raised issues that would require further consideration and/or search and presented new claims without canceling a corresponding number of finally rejected claims. The Examiner further noted that the amendment was non-responsive because each claim had not been provided with the proper status identifier.

On November 30, 2004, the Examiner notified Applicants, by telephone, that they should submit a revised Amendment After Final, with new claims 21-26 omitted and the status of all claims properly identified. Applicants then prepared the enclosed revised Amendment After Final.

Applicants submit that, since the Office communication mailed on November 30, 2004, addresses solely the Amended Appeal Brief, the enclosed Amendment After Final--prepared in light of the November 16, 2004, Office communication, and the November 30, 2004, telephone conversation with Examiner Nguyen--is fully responsive to the November 30, 2004, Office communication.

**AMENDED APPEAL BRIEF**

During the November 30, 2004, telephone conversation, the Examiner notified Applicants that the Appeal Brief was non-compliant, since it improperly referenced new claims 21-26, which had not been entered. The Examiner further explained that the statement in the Appellate Brief regarding the separate patentability of Groups I-III, as required under 1.192(c)(7), was deficient. The Examiner suggested submission of a revised and compliant Appellate Brief, with all references to claims 21-26 excised and including a compliant statement of separate patentability, as appropriate. Applicants then prepared the enclosed Amended Appellate Brief.


As noted, the Office communication mailed November 30, 2004, was received by Applicants after the Amended Appeal Brief had been prepared. The November 30, 2004, Office communication indicates that the Appellate Brief mailed July 29, 2004, was not acceptable because “the applicant does not identify which group of claims stand or fall together,” an issue that had been raised by the Examiner, by telephone, on November 30, 2004. Applicant respectfully submits that, since the Amended Appeal Brief was revised to contain only one group of claims, no statement or argument for separate patentability is required, pursuant to 35 C.F.R. § 1.192(c)(7), and such statement has been omitted.

Accordingly, Applicants submit that the Amended Appeal Brief is fully responsive to the Office communication mailed on November 30, 2004.

Applicants wish to express their thanks to the Examiner for identifying the non-compliant features of the Appellate Brief and Amendment After Final submitted on July 29, 2004, and for providing Applicants with an opportunity to submit the enclosed Amended Appeal Brief and revised Amendment After Final.

Respectfully submitted,

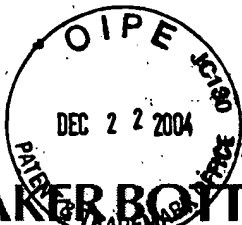
Dated: December 16, 2004

By:   
David Loretto  
Reg. No. 44,374, for;

Gary M. Butter  
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Attorneys for Applicant(s)

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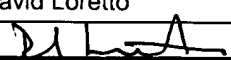
**BAKER BOTTS LLP**

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<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/593,785
	Filing Date	June 14, 2000
	First Named Inventor	Shreiner et al.
	Group Art Unit	3635
	Examiner Name	Chi Q. Nguyen
Total Number of Pages in This Submission	Attorney Docket Number	AP32438 070121.0425

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input checked="" type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): 1. Response to 11/16/04 and 11/30/04 office communications 2. Amended Appeal Brief. 3. Amendment after Final OA
Remarks <input type="checkbox"/>		

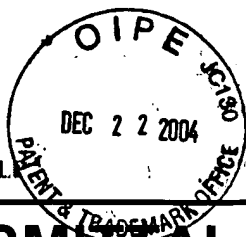
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	BakerBotts LLP 30 Rockefeller Plaza New York, NY 10112
Signature	Att Name: David Loretto PTO Reg: 44,374
Date	December 16, 2004

CERTIFICATE OF MAILING	
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Typed or printed name	David Loretto
Signature	
Date	December 16, 2004

Title: EXPANSION JOINT COVER WITH MODULAR CENTER PLATE

Use Space Below for Additional Information:

BAKER BOTTS LLP



# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 0)

## Complete if Known

Application Number	09/593,785
Filing Date	June 14, 2000
First Named Inventor	Shreiner et al.
Examiner Name	Chi Q. Nguyen
Art Unit	3635
Attorney Docket No.	AP32438 070121.0425

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

 Deposit  
Account  
Number  
Deposit  
Account  
Name

02-4377

Baker Botts LLP

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments

☒ Charge any additional fee required under 37CFR 1.16 and 1.17

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$ 0)

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		Extra Claims		Fee from below		Fee Paid	
Independent		- 20 =	0	X		=	0
Multiple Dependent		- 3 =	0	X		=	0

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ 0)

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,300	2453	650	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	630	2503	315	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 0)

## SUBMITTED BY

(Complete if applicable)

Name (Print/Type)

David Loretto

Registration No.  
(Attorney/Agent)

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Telephone 212.408.2584

Signature

Date

December 16, 2004